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Patent
Attorney Docket No. GEMS8081.023

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICIAL

In re Application of : Durbin et al.
Serial No. : 09/681,017 ✓
Filed : November 22, 2000
For : Method and System To Remotely Enable Software-Based
Options For A Trial Period
Group Art No. : 3621
Examiner : Hewitt, C.

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

I hereby certify that, on the date shown below, this correspondence is being:

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RESPONSE TO 1-15-04 INTERVIEW SUMMARY

Dear Sir:

Responsive to the Interview Summary mailed January 15, 2004, please find the following remarks:

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On the afternoon of January 9, 2004, a telephone call was placed to Examiner Hewitt. During the telephone call between the undersigned and Examiner Hewitt, the undersigned asked the Examiner for his interpretation of specific elements of each independent claim and pointed out that the undersigned believed that the prior art lacked teachings regarding those elements.

On one point in particular, the undersigned questioned the Examiner's assertion in the Final Office Action mailed November 13, 2003, that "the Applicant has not eliminated the possibility of a system ID being equivalent to a user ID." The undersigned pointed out that claim 11 calls for the receipt of "a user I.D." and "if the user I.D. is validated, receiv[ing] a system I.D. and validat[ing] the system I.D." and, therefore, claim 11 is clear that a system I.D. is not the equivalent of a user I.D..

The Examiner explained that the Examiner did not consider these elements of claim 11 because, in the Examiner's opinion, the elements contain "improper conditional language." The Examiner never made such a rejection in the file history. The Examiner explained that he believes that claim elements containing conditional language employing an "if-then" statement are open-ended, improper, and need not be considered by the Examiner when examining the application. The Examiner explained that he believes that "if-then" statements are not proper and gave these claims no weight in examination.

The undersigned explained that the Examiner's decision to ignore entire elements of claims containing an "if-then" statement is improper under the MPEP, C.F.R., and substantive case law on point. However, the Examiner insisted that an "if-then" statement may be properly disregarded and, as such, the Examiner squarely admitted that when examining claims 11, 18, and 23 of the present application, the Examiner entirely ignored any element that included an "if-then" statement. The undersigned requested that the Examiner provide an Interview Summary explaining the Examiner's position and the fact that the Examiner disregarded claim elements when the elements include an "if-then" statement. Further, the undersigned requested that the Examiner provide pin-point citations to the MPEP, C.F.R., and relevant case law to support the Examiner's position.

The Examiner provided an Interview Summary that merely stated that the undersigned and the Examiner "had a lengthy discussion on the proper analysis of 'conditional language'" but no agreement was reached. The Interview Summary included a convoluted example that purports to explain the nature of the Examiner's position using "Applicant's representative's interpretation". However, this "interpretation" was incorrect. Further, contrary to the


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undersigned's request, the Examiner failed to explain why the Examiner ignored any and all claim elements including "if-then" "conditional language" or provide any citations supporting the Examiner's position to ignore such elements.

The Examiner's position is improper. For purposes of Appeal, Applicant hereby requests that the Examiner provide support for his position, and re-open prosecution to properly examine the claims in accordance with proper examination standards set forth in the MPEP.

Respectfully submitted,



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Dated: February 12, 2004
Attorney Docket No.: GEMS8081.023

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